

The Applicants request that final rejection of the present application be withdrawn pursuant to MPEP 706.07(a), which states in relevant part:

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement” (Emphasis added.) MPEP 706.07(a).

First, previously-pending dependent claims 129, 131, 132 and 152 were found to contain allowable subject matter in the Office Action dated May 8, 2006. More specifically, the Patent Office stated in the May 8, 2006 Office Action that “[c]laims ... 129, 131, 132, ..., 152 are tentatively objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.”

The Applicants responded by re-presenting claims 129, 131, 132 and 152 in independent form, as new claims 158, 159 and 162, respectively (with claims 131 and 132 being combined as new claim 159). Asai et al. is a newly cited reference against claims 158, 159 and 162. Thus, although the subject matter of previously-pending claims 129, 131, 132 and 152 was found to be allowable, once these claims were re-presented in independent form, Asai et al was used to reject these claims. Asai et al. was not relied upon for any rejection in any prior Office Action, and therefore is a new ground of rejection of these claims. Furthermore, previously pending claims 129, 131, 132 and 152 were never rejected on any grounds in any prior Office Action.

In addition, numerous other claims were found to contain allowable subject matter in the Office Action dated May 8, 2006, but were subsequently rejected based on Asai et al in the instant Final Rejection. More specifically, previously-pending claims 112, 113, 116, 117, 129, 131, 132, 144 and 152 were found by the Patent Office to contain allowable subject matter as of May 8, 2006. In the September Response, the Applicants amended the independent claims upon which the above-referenced claims depend in a manner that did not broaden the scope of the claims. For example, the Applicants previously amended claim 108 as follows:

108. (Currently Amended) A hard disk drive comprising:

a drive housing; and

an asymmetrical storage disk that is rotatably coupled to the drive housing, the storage disk including a substantially rigid body region, a first side region that stores data and a second side region opposite the first side region, the body region being positioned between the side regions, the second side region including an exposed outer flat section and a raised stiffener that increases the rigidity of the storage disk, the stiffener extending at least approximately 0.001 millimeters away from the outer flat section.

These amendments add modifiers that describe the type of disk drive, and the type of body region.¹ These types of amendments do not require a new ground for rejection, nor do they require reliance on a newly cited reference. In other words, the new grounds of rejection were not necessitated by Applicants' amendment or by information in a newly submitted information disclosure statement (Asai et al was cited by the Examiner, not the Applicants). As a result, the instant Final Rejection is premature and should be withdrawn pursuant to MPEP §706.07(d).

MPEP §706.07(d) provides in relevant part: "If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection." MPEP §706.07(d). Thus, the Applicants respectfully submit that pursuant to MPEP §706.07(a), the instant Final Office Action should be withdrawn in accordance with MPEP §706.07(d).

If, for any reason, the instant request for withdrawal of the final rejection is denied and the finality of this action is maintained, the instant Amendment and Response should be accorded expedited treatment because it is effectively filed within two months of the date of the Final Office Action. The Applicants have complied with the provisions of 37 C.F.R. § 1.116, and request that this Amendment and Response be considered after Final Rejection.

¹ As of May 8, 2006, previously-pending claims 112, 113, 116 and 117 depended from amended claim 108. Previously-pending independent claims 125, 141 and 150 were also amended in a somewhat similar manner as claim 108. Claims 129, 131 and 132 depend from claim 125; Claim 144 depends from claim 141 and claim 152 depends from claim 150.